

REMARKS

I. INTRODUCTION

In response to the Office Action dated October 1, 2003, the claims have not been amended. Claims 1-34 remain in the application. Reconsideration of the application is requested.

II. DRAWING AND NON-ART REJECTIONS

In paragraphs (2) and (3) the drawings were objected to as failing to show every feature of the invention specified in the claims under 37 CFR 1.83(a). Specifically, the Office Action states that the claimed scenarios involving interaction between a "hand held computing device" with multiple "set top boxes" of that are "different" as well as the claims and are involving the interaction between a "set top box" and multiple "hand held computing devices" must be shown or the feature(s) canceled from the claim(s).

In paragraph (4) of the Office Action, claim 33 was rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action provides:

In particular, the Examiner is unclear as to where support may be found describing the scenario whereby a "first" and a "second handheld computing device" may interact with a "set top box" wherein the "first" and "second hand held computing devices" are "different". The disclosure suggests that a single "hand held computing device" is operable with multiple set-top boxes (Page 14, Lines 26-28), however, as aforementioned it is unclear as to where support is found for multiple "hand held computing devices" being operable to interact with a single set top box.

Applicant traverses these rejections. Support is found in both the drawings and specifications for the claimed scenarios. With respect to the drawings, 37 CFR 1.83(a) provides:

The drawing in a non-provisional application must show every feature of the invention specified in the claims. However, conventional features disclose in the description and claims, where their detailed illustration is not essential for proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or labeled representation (e.g., a labeled rectangular box).

Applicant agrees that the drawings must show every feature of the invention specified in the claims. However, as cited in 1.83(a), conventional features may be illustrated in the form of a graphical drawing symbol or labeled representation. This is true for conventional features that are described in the description and claims and where their detailed illustration is not essential for proper understanding of the invention. The claimed scenarios that the Office Action refers to are conventional features that are described in the specification and claims. Accordingly, a detailed

illustration is not essential for a proper understanding of the invention. The locations where these scenarios are described in the specification are set forth below.

With respect to the graphical drawing symbol or labeled representation, multiple figures provide such support. Figure 1 illustrates a PDA 114 and set top box 110. The set top box 110 is a set top box that is compatible with multiple handheld devices/PDAs as recited in specification (see below). Accordingly, multiple different set top boxes may be used interchangeably as set top box 110. Further, PDA 114 is also a hand held computing device that may interact with any compatible set top box. Accordingly, PDA 114 can represent multiple different hand held computing devices that can interact with a compatible set top box 110. Thus, the labeled representations 114 and 110 are general boxes (where a detailed illustration is not necessary) that clearly provide support for the claimed invention.

Figure 2 also illustrates such compatible hand held computing devices 114 and compatible set top boxes 110 that communicate with each other. Figure 4 further provides specific support for practicing the method of the invention. Step 408 provides for transmitting information to a box. The text on page 14 of the specification lines 24 through 30 provides that a "transmission may be to a set top box 110 that is different from the original set top box the received transmission from the satellite, or it may be the same set top box." Thus, multiple set top boxes communicating and interacting with a handheld computing device is provided for in step 408 of Figure 4. Step 408 also supports the scenario for multiple handheld computing devices interacting with a set top box. Such a scenario is supported by text on page 13 of the specification lines 14-17 and 23-27 that provide that the PDA may communicate with any compatible set top box.

The notion that a handheld device may communicate with any compatible set top box indicates that a set top box may interact with multiple different PDA's as long as that set top box is compatible with those other handheld devices. Page 12, lines 8-12 also provide that any user can modify "a music CD in any hotel room or other location while on vacation as long as that facility has a compatible set top box 110." Thus, throughout the text of the specification (that is supported in the drawings), the application discusses in numerous manners, the use of different handheld devices with compatible set top boxes. The specification provides that any user may use his or her handheld device (e.g. to modify a music CD) with a compatible set top box while on vacation. Such a concept clearly indicates that different PDAs/handheld devices may be used with a set top box

and hotel room. Otherwise, the set top box in a hotel room would be useless, since it could only communicate with a single user and not with a guest using his/her PDA on vacation there (as described in the specification).

In view of the above, Applicant submits that both the drawings and specification provide support for the claimed invention. Accordingly, Applicant respectfully requests that the rejections/objections be withdrawn.

III PRIOR ART REJECTIONS

In paragraphs (8)-(9) of the Office Action, claims 1-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Perlman, U.S. Patent No. 6,169,879 (Perlman) in view of PocketTV™ article (PocketTV™). Specifically, the Office Action merely repeats the same rejections previously cited:

In consideration of claims 1-2, 12, and 21-22, the Perlman et al. reference discloses a method, system, and article of manufacture for facilitating communications between a "set top box" [40] and a VCR [130]. As there is no explicit recitation that the "first" and "second set top box" are the different, the examiner shall presume that they are the same for all dependent claims, as recited claim 2 and 22. The reference discloses that the "set top box" [40] is operable to "receive" and "transmit audio/video information" from/to any of the connected sources including a VCR [130] (Col. 9, lines 23-30, 46-49). The reference further teaches that the VCR [130] is operable to "store" the "audio/video information" from any of the connected sources and to subsequently "transmit" the stored material to the "set top box" [40] for display on an "output device" [110] (Col 9, lines 58-61).

The reference, however, does not explicitly disclose nor preclude that the aforementioned VCR [130] may not be a "hand held computing device having a memory" as embodied by a PDA. It is arguable that the VCR [130] may be broadly construed as being a hand held computing device, in so far as it is feasible that at some point in time it may be "hand held" while being carried or moved. Assuming arguendo, the Perlman reference suggests that the "set top box" [40] is operable to interconnect any consumer electronic device (Col 6, lines 43-60). The "PocketTV Brings Video to Palm-size PC" article explicitly discloses that with their software a "handheld or Palm-size PC becomes a miniature VCR". Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize a "hand held computing device having a memory" as a VCR as disclosed in the PocketTV™ article in conjunction with the "set top box" [40]/VCR [130] interconnection teachings of Perlman for the purposes of enabling the recording/storage of "audio/visual information" on a device that may advantageously allow for the storage of an entire movie in your pocket (PocketTV™ article).

In response, Applicant reasserts the arguments that were previously asserted. Specifically, the capability for a handheld computing device to transmit audio/visual information to a set top box which is then displayed on an output device (as claimed) is not described, taught, or suggested by either Perlman or the PocketTV™ article, either alone or in combination.

The rejection relies on the PocketTV™ article to teach the hand held computing device having a memory. In this regard, the PocketTV™ device is equated to a VCR with various capabilities consistent with Perlman. However, the PocketTV™ device is not equivalent to the claimed hand held computing device and does not perform or provide the same capabilities as claimed.

The article does state that the Palm-size PC becomes a miniature VCR. However, the information that follows in the article clearly illustrates that the PocketTV™ merely has the capability to display video on the Palm-size PC. In other words, the PocketTV™ is merely a TV that fits in your pocket (i.e., a pocket television). Further, the "VCR" capabilities cited in the article merely refer to the ability to play the content on the Palm-size PC. The fourth paragraph of the article further elaborates that the streaming video is brought directly to "your pocket". Thus, the PocketTV™ device is clearly limited to receiving the MPEG video and is not capable of transmitting that video back to a set top box as claimed.

Further, merely stating that a "palm-size PC becomes a miniature VCR" does not teach, describe, or suggest that the palm-size PC is capable of (1) recording audio/visual information transmitted from a set top box; and (2) transmitting audio/visual information stored in the device to a set top box for playback on another device. This lack of capability to transmit information from the PocketTV™ palm-size PC clearly illustrates and teaches away from equating the PocketTV™ palm-size PC to the VCR used in Perlman. Further, since the PocketTV™ article merely provides for displaying the video on the palm-size PC itself, the article teaches away from transmitting and/or displaying the audio/visual information on another second device.

The MPEP §706.02(j) provides that "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Further, "a reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference's disclosure will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought

by the Applicant. *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994). "If when combined, the references 'would produce a seemingly inoperative device,' then they teach away from their combination." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2d 1130 (Fed. Cir. 1994) (quoting *In re Spinnoble*, 405 F.2d 578, 587, 160 U.S.P.Q. 237, 244 (C.C.P.A. 1969).

The Office Action provides that the suggestion to combine would be generally available to one of ordinary skill in the art. However, in view of the fact that the PocketTV™ article teaches away from transmitting information to a set top box and the fact that the capabilities as described in the article are limited to display on the palm-size PC itself, Applicant submits that one of general knowledge would not be motivated to combine the references.

In response to these previously sent arguments the examiner provides:

Applicant's arguments filed 25 August 2003 have been fully considered but they are not persuasive with respect to the rejection under Perlman in view of the PocketTV™ article.

With respect to the Applicant's remarks pertain to the combine teachings of the Perlman and PocketTV™ article, these ever notes that the users of the PocketTV™ article optionally relied. The Applicant's remarks are nonresponsive with respect to the grounds of rejection under the single Perlman reference. The examiner rejected claims 1-2, 12, and 21-22 based on the use of the Perlman VCR as a "handheld computing device". The claims were not limited with respect to the nature of the "handheld computing device" such that it was necessarily embodied within a PDA or similar device. No comments were provided by the Applicant to traverse the rejection using the single Perlman reference.

Applicant respectfully disagrees with such an assertion. Neither the prior Office Action nor current Office Action rejected claims based solely on the Perlman reference. The headers of all of the rejections (in the Office Action) specifically rejected claims based on both the Perlman and PocketTV™ article. Accordingly, the only rejections were based on a combination of the Perlman and PocketTV™ article. Further, in the response to the original rejection, the Applicant specifically provided that "the capability for a handheld computer device to transmit audio/visual information to a set top box which is then displayed on an output device (as claimed) is not described, taught, or suggested by either Perlman or the PocketTV™ article, either alone or in combination."

Based on the rejection itself and the headers, Applicant assumed that the rejection was based on both the Perlman and the PocketTV™ article. However, hidden in the text of the rejection itself the Office Action provides that the Perlman VCR [130] may not be a "handheld computing device having a memory" as embodied by a PDA." Instead, the Office Action states that is arguable that the VCR [130] may be broadly construed as being a handheld computing device, insofar as it is feasible that at some point in time it may be "hand held" while the carrier moved.

Applicant specifically traverses the assertion that Perlman's VCR [130] may be broadly construed as being a handheld computing device since at some point in time the VCR may be "handheld" while be carried or moved. Carrying or moving a VCR from one house to another is not even remotely similar to stating that the VCR is a handheld computing device. The background of the invention on page 2, line 27-page 3, line 19 describes handheld computing devices.

In addition, page 7, lines 11-18 specifically define the handheld computing device as claimed:

In accordance with one or more embodiments of the invention, the set top box 110 is controllable by a handheld computing device or PDA 114. As described herein, a handheld computing device, is any small device that maintains the ability to performed the functionality described with respect to the present invention. Such devices include but are not limited to devices that are configured to receive, transport, or store information or perform computations, calculations, etc. Alternatively, or in addition to controlling set top box 110, PDA 114 may provide for the storage and playback of information transmitted from set top box 110.

Nowhere in any of the text of the specification is there any reference, suggestion, or teaching, implicitly or explicitly, that the handheld computing device (as claimed) is even remotely similar to a standard VCR of Perlman and as suggested in the Office Action. Perlman's VCR is not a small device. Further, Perlman's VCR is not handheld. The only time the Perlman VCR is handheld is when it is being held by someone's hands while being moved or transported from one physical location to another physical location where it may be plugged into an AC outlet and a television or a hub and spoke configuration as described in Perlman. Suggesting that a VCR is equivalent to a handheld computing device is not only contrary to that stated in the present specification, but is contrary to the term handheld computing device as commonly used. In this regard, the American Heritage dictionary defines the term "handheld" as follows:

hand-held also **hand held** (hănd' hēld')
adj.

Compact enough to be used or operated while being held in the hand or hands: *a hand-held video camera.*

*Source: The American Heritage® Dictionary of the English Language, Fourth Edition
Copyright © 2000 by Houghton Mifflin Company.
Published by Houghton Mifflin Company. All rights reserved.*

Clearly, Perlman's VCR is not compact enough to be used or operated while being held in the hand or hands. Instead, it is only "handheld" when it is being moved or carried. In this regard, even the Office Action provides that the only way that the Perlman VCR is a handheld computing device is that it may at some point in time be "handheld" while being carried or moved. Accordingly, it is

clear that Perlman completely fails to teach that handheld computing device aspect of the invention as claimed.

The Office Action continues:

With respect to the Applicant's remarks pertaining to the combined teachings, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Perlman reference discloses that a VCR [130] is operable to "store" the "audio/video information" from any of the connected sources and subsequently "transmit" the store material to the "set top box" [40] for display on an "output device" [110] (Col 9, Lines 58-61). The Perlman *at al.* reference is not explicitly disclose or preclude that the VCR is necessarily a "handheld computing device" such as PDA. As noted by the Applicant, the PocketTV™ article clearly equates the PocketTV™ with a VCR thereby creating the suggestion to one ordinary skill in the arts as to the existence of a "handheld computing device" that is also VCR and advantageously portable. The "HP Jornada 430se" platform reference by the article inherently supports the ability to both transmit and receive data to/from the device (HP Jornada: User Guide-Page 8). This transmission may be to a "computer" such as that of Perlman (Col 6, Lines 49-60). Furthermore, the Perlman reference suggest that the "set top box" [40] is operable to interconnect any consumer electronic device (Col 6, Lines 43-60). Accordingly, when taken in combination the combined reference disclose a hypothetical embodiment wherein a "handheld computing device" may interconnect with a set top box to receive/record media and may further playback this media either through an output device such as a television set while locally connected or through an on-screen display if the user would like to watch the record movie on the road.

Applicant agrees that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. However, as stated above and under MPEP 706.02(j), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. There is no such motivation to combine the PocketTV™ article and the Perlman reference.

Firstly, the Office Action equates Perlman's central electronics device 40 to the set top box of the claimed invention. Applicant disagrees with such a suggestion. Perlman's central electronics device 40 is merely a central device in a hub and spoke configuration that various home entertainment system components are connected to (see column 9, lines 14-65). In fact, one of the components that may be connected to the central electronics device 40 is a cable box 122. Such a cable box may be similar to a set top box. Accordingly, instead of the central electronics device 40 being equivalent to the set top box, Perlman's cable box 122 may resemble or be similar to the claimed set top box. In this regard, Perlman's cable box 122 does not receive information from a VCR or other component. Perlman's cable box 122 would not know what to do or how to process

such information. Perlman's cable box 122 merely tunes scrambled television channels (col. 10, lines 50-52).

Secondly, Perlman completely fails to describe the use of a handheld computing device as claimed. The Office Action specifically provides that Perlman does not explicitly disclose a VCR that is a handheld computing device such as a PDA. As described above, a handheld computing device as a specific meaning as set forth in the description and as understood in the art.

To teach such a handheld computing device, the Office Action relies on the PocketTV™ article. As described in the prior response, the article non-descriptively references a handheld or palm-sized PC that's is capable of playing movie files. The article states that the palm-sized PC becomes a miniature VCR because you can put an entire movie in your pocket. However, you must take particular note to understand that this is a quote from marketing of MpegTV who is releasing PocketTV™ for a finance article on Yahoo and is not describing the actual functionality of the PocketTV™ device. Accurately reading the article informs us that the PocketTV™ device is merely capable of playing a movie on the device itself. There are no instructions, details, descriptions, or other information, that describes how, what, or why the PocketTV™ device can be used or becomes a VCR. Specifically, the only description in the article provides:

MpegTV announces PocketTV™, the first MPEG movie viewer for Windows-CE palm-sized and handheld PCs. PocketTV™ is capable of playing movie files encoded in the standard MPEG-1 format.

Based on this information it is clear that the PocketTV™ is merely a movie viewer, and does not provide the functionality of the present invention as claimed.

The Office Action then relies on the HP Jornada user guide. Applicant notes that the final Office Action is the first time that the HP Jornada reference was ever cited or provided to Applicant. Further, the prior amendments did not necessitate such a citation. Accordingly, reliance on such an article in the form of a final Office Action is improper.

Nonetheless, to expedite prosecution, Applicant is addressing the HP Jornada reference herein. The HP Jornada appears to provide for sending and receiving files by infrared beam between a PC and a handheld PC (see page 8). However, the mere ability to send files between a handheld device to a PC, is not even remotely equivalent to transmitting audio visual information from a handheld device to a set top box. In fact, the PocketTV™ article merely teaches playing a

movie file on the device itself and does not even remotely allude to transmitting that movie file to a set top box for display on another device. In this regard, since the article exclusively provides for displaying the movie on the device itself, it teaches away from such a transmission for display on another device. There is no reference, suggestion, or even motivation, within the PocketTV™ article or the Perlman reference, explicit or implicit, to combine the references together or that teaches the transmission of an audio-visual file from a handheld device (such as the HP Jornada) to a set top box for display on a television.

To suggest that a combination of Perlman (which describes a hub and spoke configuration where a VCR can be connected to a central component which is connected to TV) with the PocketTV™ article (which teaches displaying a movie on a handheld device) is equivalent to using a handheld computing device to receive audio/visual information and then transmit such information to a set top box for display on output device is not even remotely possible. In this regard, Applicant submits that the references cannot be combined. However, assuming that the references can be combined, even the combination would not teach the claimed invention. Instead, such a combination could potentially teach receiving information in the PocketTV™ device from a VCR or cable box through the central electronics device for playback on the PocketTV™ device itself. Again, such a teaching is not even remotely similar to the invention as claimed.

In addition, the various elements of Applicant's claimed invention together provide operational advantages over the systems disclosed in Perlman and PocketTV™. Further, Applicant's invention solves problems not recognized by Perlman and PocketTV™.

Thus, Applicant submits that independent claims 1, 12, and 21 are allowable over Perlman and PocketTV™. Further, dependent claims 2-11, 13-20, and 22-34 are submitted to be allowable over Perlman and PocketTV™ in the same manner, because they are dependent on independent claims 1, 12, and 21, respectively, and because they contain all the limitations of the independent claims. In addition, dependent claims 2-11, 13-20, and 22-34 recite additional novel elements not shown by Perlman and PocketTV™.

IV. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicant's undersigned attorney.

Respectfully submitted,

Arthur R. Tilford

By his attorneys,

GATES & COOPER LLP
6701 Center Drive West, Suite 1050
Los Angeles, California 90045
(310) 641-8797

Date: December 1, 2003

JSF/sjm/amb

By: Jason S. Feldmar

Jason S. Feldmar
Reg. No.: 39,187